

REMARKS/ARGUMENTS

The Office Action mailed November 6, 2007, has been received and its contents carefully considered. In the Office Action mailed November 6, 2007, Claims 1-13 stand rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action.

Claims 1, 3-20 are pending. Claims 1, 3-13 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. Claims 14-20 have been newly added. Claim 2 has been canceled without prejudice or disclaimer of its subject matter. All the pending claims at issue are believed to be patentable.

CLAIM REJECTION – 35 U.S.C. § 102(b)

Claims 1-4, 6, 7, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/059251 to Malin (Malin). The Applicants respectfully traverse.

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

The Examiner stated that Claims 1-4, 6, 7, & 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Malin (WO02/059251; an English translation of this reference can be found in US2004/0115101 and rejections listed in this office action are referenced to the English translation). Regarding Claim 1, the Examiner stated that Malin teaches a climatic cabinet (Figure 1a; [0049]), with a door ([0046]), a utilization space ([0045]), at least one specimen storage device ([0003]), at least one inner transport device ([0053]), and at least one transfer opening ([0046]), characterized in that a buffer specimen storage device ([0081]), and an outer transport device ([0083]) are arranged outside the transfer opening and that the outer transport device establishes a transport connection between the buffer specimen storage device and the transfer opening by which a specimen can be moved between the buffer specimen storage device and the inner transport device.

However, Malin does not mention the possibility of storing the specimen in a buffer storage device. Usually, the transfer device is not used for storage because the climatic conditions cannot be controlled and the transport times for the specimen are generally kept as short as possible. Thus, it is not clear from Malin that there is any buffer storage device for the specimen intended or used. On the other hand, if it is argued that the description and the figures of Malin can be interpreted as showing a climatic cabinet like the subject of the present invention if the external object conveyor system 100 (see paragraph [0083]) is understood as being simultaneously transport device and buffer storage device, but still then, the known device of Malin can only control the temperature of one specimen at a time in the temperature adaptation device 40 (see paragraph [00761]). In the whole description of Malin, it is said that the devices 40 and 40' can handle one object at a time because the tempered plate has approximately the size of one object (see paragraph 10072)].

Additionally, the amended claim 1 includes the limitations of claim 2 which are not disclosed.

For Claim 2, the Examiner states that Malin teaches the climatic cabinet according to Claim 1, characterized in that the buffer specimen storage device comprises a plurality of

specimen storage locations ([0083]). The Examiner takes the position that an automatic conveyor system implies a plurality of specimen storage locations.

However, respectfully, implication or inherency is not proper for the rejection. Inherent description is not pertinent in this discussion, because inherency is involved only where a minor, well-known feature is lacking. Further the CCPA has added that "inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). As mentioned in the claim and specification of the present invention, the buffer specimen storage device having a plurality of specimen storage locations is not a trivial concern.

For Claim 11, the Examiner states that Malin teaches the subject matter according to Claim 1, characterized in that a device is present for the pre-air-conditioning of the buffer specimen storage device and/or of the outer transport device ([0089]). Examiner takes the position that the air from the device for pre-air-conditioning can travel through the couplings and into the buffer specimen storage device.

Malin does not teach a pre-air-conditioning of the outer transport device because apart from the external transport device just a separate temperature controlling device 40 is present which can only take one specimen at a time. It also shows the technical advantage over the teaching of Malin in that there is a buffer storage for climatic cabinets for a plurality of specimen which can have a predetermined temperature. Thus, a more efficient and automatic handling of the specimen is given in combination with a safer temperature control. Icing of the handling blades of the transport system is especially hindered even for a plurality of specimen handled in fast succession,

CLAIM REJECTION – 35 U.S.C. § 103(a)

Claims 2, 5, 8, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milan in view of U.S. Patent 6,129,428 to Helwig et al. (Helwig).

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 2, 5, 8, 9, & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milan in view of Helwig et al (US6129428). Regarding Claim 2, the Examiner states that Milan teaches all of the Claim limitations according to Claim 1. The Examiner states that Milan does not explicitly describe that the buffer specimen storage device comprises a plurality of specimen storage locations. The Examiner states that Helwig et al teaches this feature (Figure 3a in view of Figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Milan with Helwig et al because according to Helwig et al, this would limit the large amount of climatic fluctuations experienced in the use of climatic cabinets (Column 3 lines 7-18). For Claim 5, the Examiner

states that Milan teaches the climatic cabinet according to Claim 3. Milan does not teach that the buffer specimen storage device comprises several specimen storage cassettes in a carousel arrangement. Helwig et al teaches this feature (Figure 3a). The Examiner states that would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Milan with Helwig et al because this would limit the large amount of climatic fluctuations experienced in the use of other climatic cabinets (Column 3 lines 718). The Examiner states that for Claim 8, the Examiner states that Milan teaches all of the of claim limitations according to Claim 1. The Examiner states that Milan further teaches several transfer openings (Figure 2.; Examiner takes the position that the front door and the auxiliary door can both be considered transfer openings). The Examiner states that Milan does not teach that there are several transfer openings by which correspondingly many specimen storage devices are loaded by several inner transport devices, characterized in that the outer transport device has an operative connection to all transfer openings. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Milan to have several transfer openings by which correspondingly many specimen storage devices are loaded by several inner transport devices, characterized in that the outer transport device has an operative connection to all transfer openings because this would increase efficiency and the limitation of Helwig et al which states that the two carousels are not for short term intervals. Examiner takes the position that if the carousels were used for short term intervals, the temperature of the cabinet would rise and would be harder to maintain. The Examiner states that The use of multiple transfer openings, inner and outer transfer devices, and multiple carousels would be obvious to compensate for the limitations described by Helwig et al.

In respect to point 12 of the present examination report, with respect to claims 2, 5, 8, 9 and 10, respectfully the Examiner is not correct when stating that Helwig shows a plurality of specimen storage spaces in an external buffer storage system like the present invention. Helwig shows a handling device with a plurality of storage spaces inside of the inner utilization space. Systems like that are well known in the art but they cannot be easily

transferred to the outer space of the climatic cabinet because many specimen would loose their preset temperature or the needed atmosphere.


The position of the Examiner in respect to points 12-14 (claims 2, 5, 8, 9, 10) appears to relate to an ex-post-facto perspective because for the person skilled in the art it was apparently not obvious to have a buffer storage device for a plurality of specimen outside the utilization space. Additionally, no hint is given in either cited art documents in that direction and the examination has not found any other prior art document which would teach such a buffer storage. The limitations given by Helwig are not solved there by any hint to an device of the climatic cabinet which is located outside the utilization space. Thus, the limitations still stood for a person skilled at the time the invention was made.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 87333.3321.

Respectfully submitted,
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